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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,020	01/23/2001	Ralph J. Greenspan	P-NI 4577	9299

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EXAMINER

PARAS JR, PETER

ART UNIT PAPER NUMBER

1632

DATE MAILED: 11/06/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/768,020

Applicant(s)

GREENSPAN ET AL.

Examiner

Peter Paras, Jr.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 30-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION**Claims 1-37 are pending*****Election/Restrictions***

Applicant's election with traverse of Group II, claims 22-29, in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the Examiner has not shown that a serious search burden would be required to examine all the claims. In particular, Applicants submit that it would not be undue to search the claims of Groups I and II since the same parent strains are used in the claims of both groups. This is not found persuasive because it is maintained that each of the Inventions requires a separate search status. Moreover, the claims of Groups I and II are materially different methods that require for practice reagents having different chemical structures and technical considerations. For example, the methods of Group I are directed to identifying a network of genes that are related to Alzheimer's disease while the methods of Group II are directed to screening candidate agents that can treat Alzheimer's disease. Therefore, it is maintained that these inventions are distinct due to their divergent subject matter (identifying genes and screening potential therapeutic agents) and are thus, separately classified and searched.

The requirement is still deemed proper and is therefore made FINAL.

Please note that after a final requirement for restriction, the Applicants, in addition to making any response due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed

Art Unit: 1632

not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested. (See § 1.181.).

Claims 1-21 and 30-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

It is noted that in the claims as originally filed, two claims were submitted as claim 31. The claims have been renumbered as per rule 1.126 resulting in 37 total claims.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

The instant specification, in the first line, refers to a provisional application but fails to provide the serial number of the provisional application.

Drawings

New corrected drawings are required in this application because of the objections by the Draftsman as cited on the attached PTO-948. Applicant is advised to employ the services of a competent patent draftsman outside the

Art Unit: 1632

Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. See pages 64-65 and 67. Since the instant specification is lengthy, Applicants are encouraged to review the entire specification for other references to embedded hyperlink and/or other form of browser-executable code.

Appropriate correction is required.

Claim Rejections - 35 USC § 112, 1st paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-26 and 28-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

Art Unit: 1632

inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification has described first and second parent strains of *Drosophila melanogaster* for use in the screening methods of the invention to identify a therapeutic agent for treating Alzheimer's disease. See pages 17-34, as well as throughout the specification. For the purpose of this rejection, the term "strain" as recited in the claims can be broadly interpreted to read on species other than *Drosophila*, such as for example, bacteria, fungi, yeast, shrimp, mice, birds, snakes, elephants, or jellyfish. The specification however, has not described the other parental strains encompassed by the claims.

The claimed invention as a whole is not adequately described if the claims require essential or critical elements which are not adequately described in the specification and which is not conventional in the art as of applicants effective filing date. Possession may be shown by actual reduction to practice, clear depiction of the invention in a detailed drawing, or by describing the invention with sufficient relevant identifying characteristics such that a person skilled in the art would recognize that the inventor had possession of the claimed invention. Pfaff v. Wells Electronics, Inc., 48 USPQ2d 1641, 1646 (1998). However, it would appear that at the time the instant application was filed Applicants were not in possession of the parental strains encompassed by the claims, other than *Drosophila* as described above. The skilled artisan cannot envision the detailed chemical structure of the parental strains encompassed by the instant claims, and therefore conception is not achieved until reduction to practice has occurred,

Art Unit: 1632

regardless of the complexity or simplicity of the method of creating parental strains for use in the methods as claimed. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016 (Fed. Cir. 1991).

The skilled artisan would not recognize that applicant was in possession of the necessary common features or attributes possessed by the genus of parental strains embraced by the claims as such has not been reduced to practice by the instant specification. As such it would appear from the evidence of record that Applicant was not in possession of the genus of parental strains to be used in the claimed method as encompassed by the claims. University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that to fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention."

Claim Rejections - 35 USC § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1632

Claim 22 is unclear as written. The phrase "modification of the altered phenotype producing a phenotype with more similarity to a wild type phenotype than the altered phenotype has to the wild type phenotype" is unclear because the specification has not defined how a modified altered phenotype is more similar to a wild type phenotype than to an altered phenotype. The specification has not defined the degree of relationship between the various recited phenotypes such that it would be clear exactly what a modified altered phenotype is and how it relates to wild type and altered phenotypes. Clarification is required. Claims 23-29 depend from claim 22.

Conclusion

No claim is allowed.

Art Unit: 1632

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Peter Paras, Jr., whose telephone number is 703-308-8340. The examiner can normally be reached Monday-Friday from 8:30 to 4:30 (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at 703-305-4051. Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703) 308-4242 and (703) 305-3014.

Inquiries of a general nature or relating to the status of the application should be directed to Patsy Zimmerman whose telephone number is (703) 308-0009.

Peter Paras, Jr.

Art Unit 1632

Pete Paras Jr
Art Unit 1632